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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,610	10/25/2001	Franz Pruckner	2001-1092A	4718

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EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

54

<b>Office Action Summary</b>	<b>Application No.</b> 09/890,610	<b>Applicant(s)</b> PRUCKNER, FRANZ	
	<b>Examiner</b> Paul Marcantoni	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant's arguments filed 2/6/04 have been fully considered but they are not persuasive.

Rejection:

Claims 9-12 remain rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wagner et al. '921, Saunders, or Gasmena et al.

*Note: Neeley and Schwarz references withdrawn because date later than applicants' effective filing date.*

Response

The applicants argue that Wagner teaches protection against environmental attack. Yet, is not corrosion one force of the environment that attacks? Cathodic protection is one form of protection against the environment. The applicants argue electrical conductivity yet they argue a feature not claimed nor do they provide evidence that this is even any different over the prior art. The applicants also argue preferred embodiments with regard to Wagner with polysiloxane and the presence of graphite yet a reference is good for all that it realistically teaches and Wagner teaches the same components as applicant for their invention.

The applicants argue that Saunders differs because it is intended for heating purposes and contains large amount of graphite particles. In rebuttal, applicants argue a feature they themselves do not claim because there is no amounts or range of amounts for graphite in applicants own claim (see claim 9 of applicants). Also, Saunders teaches coating a wall that can be concrete (which is what applicants limitation of their

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claim is) and it would have been expected to also lead to protection against corrosion. Paint itself is a protective coating to prevent exposure of the raw metal to the elements to protect against corrosion and this would have been evident to one of ordinary skill in the art.

The appellants also list features a through f which are limitations not present in the claims nor do applicants present experimental evidence comparing the coating of the prior art to the coating of the instant invention. The applicants merely provide allegations of properties that has not been shown to be unexpected over the prior art. Also, the applicants argue other features such as the presence of a catalyst in their instant invention yet again this is not found in any of claims 9-12. It is improper to argue features not present in the claims.

Finally, the applicants argue that Gasmena et al. is not intended for a cathodic protection anode. The examiner disagrees. Applicants are referred to column 1, line 26 wherein it explicitly teaches in Gasmena et al. that it should be used as a "corrosion" barrier.

The applicants also argue that they do not use an oxysilane for the coating of their invention. Yet, applicants again argue a feature not claimed. There is no limitation regarding a silane or siloxane in claim 9. Also, oxysilane is still in the genus of silane materials and applicants do not specify any specific silanes for their claims.

It is also noted that applicants may consider the word —or—between silane or siloxane at the very least in claim 11. A slash mark is not supported by the original invention translated from the Norwegian application which says the word or. It can also

be misinterpreted to be a mixture of silane or siloxane by using a slash / which applicants do not have support for their invention from their original disclosure.

For the foregoing reasons, finality is now proper.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni  
Primary Examiner  
Art Unit 1755